



A DOCPHOENIX

# Office Action Summary

Application No.

09/805,455

Applicant(s)

GAN ET AL.

Examiner

Jeffrey Fredman

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on February 26, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 4,8,9,13 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 4,8,9 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The objection to the disclosure is withdrawn in view of the corrections.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4, 8, 9, and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Guru et al (Genome Research (1997) 7:725-735).

Guru teaches Bac clone 137c7, deposited in Genbank as Accession No. AC000134. This Bac comprises a genomic sequence which encodes a protein comprising the sequence of SEQ ID NO: 2, including the amino acids AIPLPA which are absent in the related protein at nucleotides 78,990 to nucleotide 78,972 (see printout of AC000134). Further, this sequence is in a BAC vector which are grown in bacterial host cells (see page 733, subheading "genomic clone sequencing"). Since this sequence is the genomic sequence of the protein, it is inherently operatively linked to the native promoter sequence for the protein. The Bac clones were then subjected to shotgun sequencing, in which the sequences were placed into plasmid vectors in bacterial host cells (see page 733, subheading "genomic clone sequencing").

### ***Allowable Subject Matter***

3. Claim 25 and 26 are allowed.

4. The following is a statement of reasons for the indication of allowable subject matter: Claims 25 and 26 are drawn to isolated sequences with closed claims. The genomic sequence does not comprise or teach the cDNA sequence of SEQ ID NO: 1 in claim 25. While the Bac comprises the genomic sequence claimed in claim 26 of SEQ ID NO: 3, the Bac is significantly larger and there is no suggestion that the particular genomic sequence of claim 26 should be separated from the larger Bac sequence.

***Response to Arguments***

5. Applicant's arguments filed February 26, 2003 have been fully considered but they are not persuasive.

Applicant argues that the Guru reference does not meet the limitation of claim 4 because the claim uses the closed "consisting of" language in the preamble regarding the nucleotide sequences. This argument is incorrect because it fails to properly interpret the claim. The claim permits any nucleotide sequence which encodes SEQ ID NO: 2. The use of "consisting of" language does not close this claim because the sequence consists of ANY sequence which can encode SEQ ID NO: 2. The sequence disclosed by Guru encodes SEQ ID NO: 2 and therefore falls within the scope of the claim, when properly interpreted. Thus, the rejection is proper and is maintained.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman  
Primary Examiner  
Art Unit 1637

March 19, 2003